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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,320	09/06/2000	Douglas G. Delany		9073

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EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/656,320

Applicant(s)

DELANY ET AL.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This Office Action is in response to the RCE filed 1-28-04.

Claim Objections

Claims 11-17 are objected to because they are confusing with regard to exactly what they are trying to claim. With regard to satisfying the requirements of under 35 U.S.C. 101, in claims having computer readable mediums, they must also state some form of computer executable code. In other words, there must be some connection between the computer and the code that is saved on the computer readable medium (the storage device). As such, it is the Examiner's position that this is what the Applicant is trying to claim, but is not clearly identifying the computer executable portion of the requirement with the "means in the medium for " language. The Examiner suggests amending the claims to state either that the means in the medium is computer executable code, or amend the means-plus-function language to be 'computer executable code.'

Claim 12 is objected to because of the following informalities: the term "determining" in the phrase "usage is determining" is grammatically incorrect. The Examiner suggests amending the phrase to read, "usage is determined." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6 and 11 are indefinite because they state “at least one webserver function”, “said function” then later they recite “at least one function accessed by the user” and “the function.” It is unclear whether the subsequent references to the at least one function is the same as the webserver function that was first recited or a different one? Clarification is required.

Claims 3, 8 and 13 are indefinite because the phrase “summing amounts of usage” and “summing usage amounts” are confusing. Is the usage that of the determined usage as recited in the independent claims, or a different usage amount? If it is that of the determined usage, it should be preceded by “the” or “said” to show that proper antecedent basis has been established and avoid confusion.

Also, claim 3 is indefinite because the phrase “the step of determining a total amount” is confusing since in claim 1 the step was for “determining an amount of usage” but not necessarily a total amount. Is this step further defining the determining step of claim 1 or something different?

Claims 6-10 are also indefinite because they are directed to a “system” however it is unclear from the claim language whether the system is really for an apparatus or a method.

Claims 2, 4-5, 7, 9-10, 12 and 14-17 are indefinite because they depend from rejected base claims 1, 6 and 11.

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-10 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Zhang et al. patent (US 6,119,160) in view of the Kilkki et al. patent (US 6,230,144 B1).

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The Zhang patent disclose a method for billing users in a service provider environment comprising the steps of:

Assigning a score to each of at least one webserver function, wherein the score is a property of the function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12), identifying a user (Abstract, col. 10, lines 32-38), identifying from a file at least one function accessed by the user (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12), determining a number of uses of the function accessed by the user (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12), and determining an amount of usage by combining the number of uses of the function accessed by the user with the weight assigned to that function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12) (claim 1);

Multiplying the number of uses of the function accessed by the user by the weight assigned to that function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12) (claim 2);

Determining a total amount of usage for the user by summing amounts of usage (Abstract, col. 11, lines 17-39) (claim 3);

The file is a webserver function log file (Abstract, Figs. 2A-3 and 38-46) (claim 4); and

The file is a user log file (Abstract, Figs. 2A-3 and col. 10, lines 32-38) (claim 5).

The Zhang patent also disclose a system for billing a user in a service provider environment, wherein the system comprises:

A function weight that is assigned to each of at least one function, wherein said weight is a property of said function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12), a user identification (Abstract, col. 10, lines 32-38), at least one function that is accessed by the user

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from a file (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12), a number of uses of the function accessed by the user (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12), and an amount of usage of the user that is determined by combining the number of uses of the function accessed by the user that the weight assigned to that function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12) (claim 6);

Multiplying the number of uses of the function accessed by the user by the weight assigned to that function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12) (claim 7);

Determining a total amount of usage for the user by summing amounts of usage (Abstract, col. 11, lines 17-39) (claim 8);

The file is a webserver function log file (Abstract, Figs. 2A-3 and 38-46) (claim 9); and

The file is a user log file (Abstract, Figs. 2A-3 and col. 10, lines 32-38) (claim 10).

The Zhang patent also disclose an article for billing a user in a service provider environment, comprising:

A computer-readable signal-bearing medium (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12), means in the medium for assigning a weight to a function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12), means in the medium for identifying at least one function accessed by the user from a file (Abstract, col. 10, lines 32-38), means in the medium for determining a number of uses of the function accessed by the user assigned to that function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12), and means in the medium for determining a usage amount by combining the number of uses of each function by the weight

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assigned to that function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12) (claim 11);

The amount of usage is determined by multiplying the number of uses of the function by the weight assigned to that function (Abstract, Figs. 2A-2B, col. 1, line 59 through col. 2, line 12) (claim 12);

Means for determining a total amount of usage for the user by summing amounts of usage (Abstract, col. 11, lines 17-39) (claim 13);

The file is a webserver function log file (Abstract, Figs. 2A-3 and 38-46) (claim 14);

The file is a user log file (Abstract, Figs. 2A-3 and col. 10, lines 32-38) (claim 15);

The medium is a recordable data storage medium (Abstract, Figs. 1-3) (claim 16); and

The medium is a modulated carrier signal (Abstract, Figs. 1-3) (claim 17).

The Zhang patent discloses all the elements of the claimed invention except for the use of a weighted score, load or parameter. The Kilkki patent teaches the use of weighted loads in determining the distribution of payments in a computer network environment (Kilkii, col. 4, line 49 through col. 5, line 25). It would have been obvious to one of ordinary skill in the art to have modified the Zhang patent to include the teachings of the Kilkii patent so as to provide a “system which can be used to fairly divide the costs and incomes between operators.” (Kilkii, col. 8, lines 1-2).

Response to Arguments

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The Applicant takes the position in their response to the Advisory Action that there is no motivation in the art to properly combine the Zhang et al. patent with the teachings of the Kilkki et al. patent. The Examiner respectfully disagrees. Both references are directed to accounting systems in electronic environments, and the Kilkki et al. patent specifically states that the accounting bit, in every cell, is so that the system “can be used to fairly divide the costs and incomes between the operators.” (Kilkki, col. 8, lines 1-2). Kilkki also states that the weighting aspect of the invention is to aid in the allocation of payments among the various users. (Kilkki, col. 4, lines 50-52). As such, Kilkki provides the motivation to combine the two references, and the rejection is herein maintained.

The Applicant also states that “Zhang et al. does not relate to accounting for usage based upon the principles claimed by the Applicant. Rather, Zhange et al. is based upon accounting for connections to a service and duration associated therewith.” (Response of 1/28/04). However, Zhang et al. is not only limited to accounting for connections and disconnections only. Zhang specifically states, “the ISP and Telcos would no longer be restricted by rate schemes solely based on account logon and account logoff, but rather customers could be charged in accordance to the specific services which they access and the duration, byte-count or quantity of the connections to those service[s].” (Zhang, col. 2, lines 5-14). As such, it is the Examiner’s position that the Zhang reference as modified by the Kilkki patent renders the presently claimed invention obvious.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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